

REMARKS

This paper is filed in response to the office action mailed on November 2, 2005. In the office action the restriction requirement is made final and therefore claims 5-16 have been withdrawn. Applicant would be grateful to the Examiner if he would consolidate Groups II-V in a single divisional application as all four groups are directed towards various methods for using the device of claims 1-4. Further, applicants are a small entity and multiple divisional prosecutions would be burdensome.

Turning to the rejections based upon the prior art, the office action rejects claims 1 and 3-4 under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,741,786 ("Torrey"). In response, claim 1 has been amended to transverse this rejection.

Specially, under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Amended claim 1 cannot be anticipated by Torrey because Torrey does not teach or suggest a swirl pattern for the PSA on a coated paper. Instead, Torrey only discloses discrete dotted patterns as shown in Fig. 1, uniform rectangular patterns shown in Fig. 2, or line patterns shown in Figs. 3 and 4.

The swirl pattern is a preferred technique for the following reasons. First, as set forth in the specification, applying the PSA in a swirl pattern can be performed by machinery that already exists thereby reducing manufacturing costs. Further, the proposed swirl pattern deposits less PSA on the surface under repair. It is desirable to have a minimal amount of PSA on the surface under repair so no bumps or undulations can be seen through wall paper that is being re-applied to the surface. Further, excess amounts of PSA would be undesirable for the repair patch application (Fig. 4), as well as the door hinge application (Fig. 5) as of excess amounts of PSA would interfere with the subsequent application of paint or wall compound. Further, excess amounts of PSA are simply not necessary and would add to the cost of the claimed repair product. Thus, the swirl pattern now claimed is not taught or suggested in Torrey and is a significant advance over Torrey.

Further, with respect to the Patent Office's refusal to consider the preamble as a positive claim limitation, applicants note that

[i]f the claim preamble, when read in the context of the entire claim cites limitations of the claim or if the claim preamble is 'necessary to give life, meaning and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." MPEP §2111.02(citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999)).

Torrey is not directed toward a repair device and therefore amended claim 1 cannot be anticipated by Torrey for this additional reason. Accordingly, applicants respectfully submit that claims 1 and 4 are not anticipated by Torrey and that the anticipation rejection is improper and should be withdrawn.

Claim 2, is rejected under 35 USC§103 as being unpatentable over Torrey. However, under MPEP § 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (Citing, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); see also MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Torrey does not teach or suggest a repair device and Torrey does not teach or suggest a silicone coated sheet of release paper that is coated with PSA in a swirl pattern. The advantages of the swirl pattern are noted above. All of the patterns disclosed in Torrey are clearly regular or consistent.

Further, under MPEP § 2173.05(g),

[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to one of ordinary skill in the pertinent art in the context in which it is used.

Applicants respectfully request that the Patent Office given patentable weight to the functional limitations in the last paragraph of claim 1. Torrey does not teach or suggest these features, Torrey does not teach or suggest a repair device and Torrey does not teach or suggest PSA distributed in an irregular swirl pattern and therefore, Torrey does not teach or suggest every element of amended claim 1 and therefore the obviousness rejection fails to meet the standards of MPEP §2142.

An early action indicating the allowability of claims 1 and 4 is respectfully requested.

The Patent Office is hereby authorized credit any overpayment or charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 50-3629.

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Respectfully submitted,

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